

REMARKS

Reconsideration of the Application respectfully is requested. For the reasons indicated in detail hereafter, the Application is urged to be in condition for allowance.

A Petition for Extension of Time (three months) is being filed herewith together with the appropriate fee.

It respectfully is pointed out that a rejection of Applicant's contribution under 35 U.S.C. § 102(b) over the inadequate teachings of anything published with respect to French Breeders Rights Application No. 15433, European Plant Breeders Rights Application No. 98/0546, and the August 1998 catalog of Meilland Richardier would be inappropriate. There has been a misapplication of the law as contemplated by Congress in the Official Action.

Only a limited number of plants of the 'Meivaleir' variety were available in a limited area of the world (i.e., primarily in France) with limited publicity more than one year before the effective filing date of the present U.S. Patent Application. Such availability would have gone unnoticed by those interested in climbing rose plants elsewhere throughout the world where the vast majority of rose growers reside. The general public for all practical purposes would not even in France have known of the availability of 'Meivaleir' plants more than one year prior to the August 21, 2001 effective filing date of the present U.S. Plant Patent Application.

The hypothetical one skilled in the art had no reasonable expectation of reproducing the 'Meivaleir' variety in view of its limited availability and the nature of anything that was published more than one year prior to Applicant's effective filing date of August 21, 2001. The limited number of 'Meivaleir' plants in existence more

than one year prior to the effective filing date precluded its availability to others on more than a limited basis.

The *In re LeGrice* decision of the Court of Customs and Patent Appeals dated May 4, 1962 and reported at 133 USPQ 365 is controlling authority for Examiners of the U.S. Patent and Trademark Office and must be followed during the examination when a comparable factual situation is presented as in the present application. It was there held that in order to be a statutory bar, a printed publication with respect to a new plant variety that is sought to be patented under 35 U.S.C. §§ 161 to 165 must be adequate in its teachings to enable the reader in combination with scientific knowledge of the particular art to be in possession of the plant when taking into consideration the existing "store of knowledge in fields of plant heredity and plant eugenics which one skilled in the art will be presumed to possess." The two rose varieties under discussion in the *LeGrice* case were available to the public outside the United States well more than one year before the filing dates of the Plant Patent Applications that matured into United States Plant Patent Nos. 2,209 and 2,210.

This is confirmed at Page 2 of the February 12, 1960 *LeGrice* Board of Appeals Decision where it stated:

The publications indicate that the particular plants were on sale, and presumably also in public use, more than one year prior to the respective filing date of the applications since appellant is indicated as "raiser and distributor." However this question is not in issue since the public use or sale must be in the United States in order to bar a patent and these events, as far as anything suggested by the record is concerned, took place in England. (underlining added)

Such availability of plant material of the claimed varieties abroad was not relevant to the examination during the evaluation of a printed publication in view of

the express language utilized by Congress in 35 U.S.C. § 102. Public use and availability of the subject matter of a Patent Application in a foreign country more than one year before the filing date is not an impediment to United States Patent protection. See, the *Gandy et al. v. Main Belting Co., et al.*, Supreme Court decision cited earlier. The Judges at the Court of Customs and Patent Appeals reasonably can be concluded to have considered the underlying facts and the February 12, 1960 decision of the Board of Appeals in detail. Had the availability of plants of the subject *LeGrice* varieties outside the United States been considered to be relevant in its evaluation, it would have been addressed in the written decision. Such issue had been resolved by the United States Supreme Court many years earlier and was not open for discussion. This *In re LeGrice* decision that was written by the respected patent jurist, Arthur M. Smith, clarified the law with respect to when a printed publication can serve as a statutory bar to plant variety protection and properly was consistently applied and followed by Examiners of traditional Plant Patents pursuant to 35 U.S.C. §§ 161 to 165 for several decades following its issuance.

The subsequent decision of the Board of Patent Appeals and Interferences in *Ex parte Thomson*, 24 USPQ 2d 1618 (1992) involving a utility Patent Application was not followed by Examiners of the U.S. Patent and Trademark Office in the past for good reason. It should be recognized to constitute an ill-conceived action by the Patent Office administrative tribunal that is unsound from both technical and legal standpoints. It has never been the law with respect to non-plant inventions when similar enablement issues with respect to a publication arise. 35 U.S.C. § 102 was misapplied in *Thomson*. There is no reason for the law in this area to be different when applied to a plant invention. Further the fact situation in the *Thomson* case

cannot reasonably be distinguished from that of the controlling Court authority with respect to traditional Plant Patents - *In re Le Grice*. In both instances, there was public use and availability of plant material outside the United States more than one year before the United States filing dates. Also, the cavalier "someday is here" reasoning expressed in the *Thomson* decision should be recognized to be scientifically inaccurate. From a scientific standpoint there is today no way that even the most skilled plant scientist could reproduce the claimed 'Meivaleir' variety from a reading of anything that was published with respect to this variety more than one year prior to the August 21, 2001 effective filing date. The mere possibility for one to seek a plant in a foreign country and to bring such plant to the United States has never been an impediment to variety protection in the United States in the absence of a showing that the variety was on sale or in public use in the United States more than one year before the United States filing date. No statutory anticipation has been or is capable of being established with respect to the 'Meivaleir' variety.

As specified at 35 U.S.C. § 161, Plant Patents and Patents for other inventions are subject to the same statutory provisions "except as otherwise provided." Title 35 provides no exception capable of supporting a different rule for Plant Patents in the area of a statutory bar. This portion of the statute improperly has been disregarded. The Court of Appeals for the Federal Circuit in *In re Wilhelm Elsner* had no authority under the U.S. Constitution to seek to change the content of 35 U.S.C. § 161 as enacted by Congress and clearly was in error when it stated:

Because we perceive a difference between plants and statutorily distinct inventions, we disagree with Appellants' contention that this holding will operate to create a printed publication bar whenever a non-enabling publication and foreign sale are involved.
(underlining added)

Accordingly, a rejection under 35 U.S.C. § 102(b) would be improper since Congress has stated no difference between plant inventions and other inventions in the area of a novelty defeating statutory bar. To refer to the asexual reproduction requirement for a new plant variety that is the subject of a Plant Patent is completely irrelevant with respect to a novelty defeating statutory bar analysis. Once this erroneous reading of the statute is pointed out, the basis for the rejection vanishes.

The availability of a claimed invention in a foreign country more than one year prior to the filing of a United States Patent Application does not constitute "prior art" in view of the express language specified by Congress in 35 U.S.C. § 102. It respectfully is pointed out that the availability of an invention in a foreign country was not a novelty defeating event recited in 35 U.S.C. § 102.

No publication with respect to French Plant Breeders Rights Application No. 15433 and European Plant Breeders Rights Application No. 98/0546 indicated that plants of the 'Meivaleir' variety were available to the public anywhere. It should be recognized that the variety had only recently been created and even the originator had not had adequate time to asexually reproduce the new variety to provide a large number of plants for any purpose.

Approximately 100,000 copies of the August 1998 catalog Meilland Richardier were distributed among some amateur rose growers solely within the country of France more than one year prior to the August 21, 2001 effective filing date of the

present Application. Prior to August 21, 2000 only approximately 15,000 plants of the 'Meivaleir' variety were made available to these growers in the country of France with a very few of these plants being shipped to recipients in nearby Germany and Italy.

The number of Meilland Richardier catalogs combined with the number of available plants of the new variety pale in comparison to the European population of approximately 460,000,000 inhabitants plus the combined population of the other parts of the world which is vastly larger.

Even the populations taken as a whole in the countries of France, Germany and Italy for all practical purposes would not have become aware of the availability of any plants of the 'Meivaleir' variety in any quantity more than one year prior to the August 21, 2001 effective filing date. Also, even if the preponderance of public at large somehow became aware of the 'Meivaleir' variety at this time period (which did not occur), 'Meivaleir' plants did not exist in sufficient quantities to expand the limited nature of their availability.

Plants of the 'Meivaleir' variety were not available to the public outside of the limited area more than one year prior to the August 21, 2001 effective filing date of the present Application. Persons interested in climbing rose plants for all practical purposes in the other 150+ civilized countries of the world also were denied knowledge of and access to the 'Meivaleir' variety in their countries more than one year prior to the effective filing date of the present Application and would not have known of the existence of the new 'Meivaleir' variety.

In summary, the availability of 'Meivaleir' plants abroad more than one year prior to Applicant's August 21, 2001 effective filing date was indeed isolated and

remote for all practical purposes in the context of the global nature of the commercial rose industry even if the erroneous reading of the statute expressed in the *In re Wilhelm Elsner* decision were applied. When limited in nature the plant availability combined with a non-enabling publication is to be disregarded and does not constitute a statutory bar pursuant to the reasoning of *In re Wilhelm Elsner*.


Plants of the 'Meivaleir' variety were first made available to the public in the United States during April 2001, and less than one year prior to Applicant's August 21, 2001 effective filing date.

For the foregoing reasons, it respectfully is submitted that no novelty defeating event has taken place with respect to 'Meivaleir' variety and accordingly the withdrawal of the 35 U.S.C. § 102(b) rejection respectfully is requested.

Respectfully submitted,

BUCHANAN INGERSOLL PC (INCLUDING ATTORNEYS
FROM BURNS, DOANE, SWECKER & MATHIS)

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